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Dated: March 17, 2006

Signature

(Dennis M. Smid)

PATENT  
SONYJP 3.3-1222



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re patent application of :  
Min-Jae Han :  
: Group Art Unit: 3621  
Serial No. 09/319,093 :  
: Examiner: Kambiz Abdi  
Filed: August 16, 1999 :  
For: RECORD PLAYBACK :  
APPARATUS AND :  
RECORD/PLAYBACK METHOD :

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**APPELLANT'S REPLY BRIEF ON APPEAL**

Sir:

The present Reply Brief is responsive to the Examiner's Answer mailed January 17, 2006.

**THE REMAINING REJECTIONS IN VIEW OF THE EXAMINER'S ANSWER**

In the Examiner's Answer, the Examiner indicated that the following rejection remains:

Rejection of claims 1-18 under 35 U.S.C. 103(a) as being unpatentable over Ball et al. (EPO 0 309 298) in view of Suzuki (U.S. Patent No. 5,850,527), Yoshioka (U.S. Patent No. 4,964,109), Freeny, Jr. (U.S. Patent No. 4,528,643), and Endoh (U.S. Patent No. 5,084,790).

In the Examiner's Answer, the Examiner provided an explanation to the above rejection and a response to the applicant's arguments presented in the Appellant's Appeal Brief, which the Examiner identified as "First Issue", "Second Issue",

"Third Issue", and "Fourth Issue". The following comments are presented in response thereto.

#### The First Issue

Independent claim 1 recites in part the following:

"a payment imposing unit configured to determine .  
. . . an amount of payment based on the dubbing  
speed selected by the user . . . ." (Emphasis  
added.)

In the Examiner's Answer, the Examiner acknowledged that Ball does not disclose the above feature of claim 1. (See page 3, lines 20-21 of the Examiner's Answer.) In an attempt to overcome such deficiency, the Examiner relies on Suzuki and, in particular, lines 43-49 and 55-60 of column 6, lines 58-64 of column 9, lines 8-43 of column 10, lines 24-48 of column 13, lines 1-7 and 54-67 of column 14, lines 20-27 of column 16, lines 30-35 of column 20, and Figures 13, 14, 17, and 18 thereof. More specifically, the Examiner appears to assert that these portions of Suzuki disclose an information providing apparatus that "enables user selected information to be transmitted from a reproduction device to the user terminal and also enables the user to select a compression rate and wait period which represents the speed at which the information is transmitted and recorded to a user's local terminal. . . , which the examiner submits is analogous to the speed at which the information is provided from one device to another, such as dubbing speed. Suzuki further teaches wherein the payment imposed on the user is based on the transmission or reproduction speed selected by the user." (See lines 5-11 of page 12 of the Examiner's Answer.) (Emphasis added.)

Thus, it appears that the Examiner asserts that "compression rate and wait period" are the same as "dubbing speed." It is respectfully submitted that "dubbing speed" as used in claim 1 of the present application is substantially

different from "compression rate and wait period" as used in Suzuki. In support thereof, the following is presented.

As indicated by a reading of the present specification, "dubbing" may refer to copying of data (such as music information) from one recording medium to another recording medium. (See, for example, lines 9-11 of page 1 of the present application.) Such mediums may be optical disks or magnetic tape type mediums. Dubbing may be performed at any of a standard (or common speed) and a high speed (such as 2, 3, . . . times faster than the standard speed). As indicated in the present application, common speed dubbing may refer to a situation wherein "data stored on an optical disk rotating at a standard speed specified by applicable standards is read out and played back with the use of a head and its playback data is recorded onto another optical disk rotating at the same speed." (See line 21 of page 1 to line 2 of page 2 of the present application.) As further indicated in the present application, double or triple speed dubbing may refer to the situation wherein "data stored on an optical disk rotating at a speed two or three times faster than the standard speed is read out and played back with the use of a head and its playback data is recorded at two or three times faster clock onto another optical disk rotating at the speed two or three times faster than the standard speed." (See lines 4-7 of page 2 of the present application.) An example of a high-speed dubbing unit is illustrated as element 10 in Figure 1 of the present application. Such high-speed dubbing unit is "designed for dubbing (copying) a group of digital data at a high speed from a first recording medium or namely an optical disk 15 to a second recording medium or namely a hard disk 16 . . . ." (See lines 6-8 of page 8 of the present application.)

Accordingly, a dubbing operation conducted between a first optical disk and a second optical disk may be performed at a selected high speed (such as 2, 3, . . . times faster than the

standard speed). During such operation, the first optical disk may be rotated at the selected high-speed (e.g., twice the standard rotational speed) and the second optical disk may be rotated at the same speed (i.e., twice the standard rotational speed). Such operation enables data from the first optical disk to be reproduced therefrom at a high speed and to be recorded onto the second optical disk at the same high speed. Additionally, in such operation, the data may be copied as is from one optical disk to the other optical disk. In other words, such data may not be compressed after it is reproduced from the first optical disk. Furthermore, and as is to be appreciated, performing a dubbing operation at a high-speed enables data to be copied onto a disk (or other type of medium) in less time than if the copying were performed at the standard speed.

Thus, as indicated in the present application, the term *dubbing speed* may refer to the speed at which data (such as music information) may be read or played back from a playback medium (such as a first optical disk) and recorded onto a recording medium (such as a second optical disk) during a dubbing operation. The dubbing speed may be selected from among a number of speeds such as a standard speed (or normal playback speed) and one or more speeds each of which is N times faster than the standard speed (where N is greater than 1). For example, a dubbing speed may be selected from the standard playback speed, twice the standard playback speed, three times the standard playback speed, and so forth. Further, during a dubbing operation, the data may be reproduced from a playback medium and recorded as is onto a recording medium. In other words, during such dubbing operation, the data reproduced from the playback medium may not be compressed before being recorded onto the recording medium. Accordingly, during such dubbing operation, data may be copied from one medium to another medium in a non-compressed form at a high-speed (such as twice the

standard playback speed, three times the standard playback speed, and so forth).

On the other hand, in Suzuki, the term *compression* or *compressing* rate appears to refer to the ratio of the "information amount after compression" to "that before compression." (See lines 1-6 of column 10 of Suzuki.) (Emphasis added.) Additionally, in Suzuki, the term *wait period* appears to refer to "a period between the time when a user demands a program and that when the program is ready to be provided." (See lines 33-34 of column 14 of Suzuki.) Furthermore, as apparently indicated in the portions of Suzuki relied upon by the Examiner, during operation, a so-called compression method (such as MPEG-1, Videol, JPEG, etc.) may be selected by a user. Upon such selection, a corresponding compression rate and a "necessary band" (or transmission speed) may be designated. (See, for example, Figure 6 and lines 8-13 of column 10 of Suzuki.)

Thus, it appears that the term *compressing* or *compression* rate refers to the ratio of the amount of data after compression to the amount of data before compression. Further, in Suzuki, such compression rate or ratio appears to be only applicable to situations wherein data to be provided to a terminal has been (or will be) compressed. Accordingly, enabling a user to select a compression method which may designate a compression rate and a necessary band (or transmission speed) even along with a wait period as in Suzuki, does not appear to enable a user to select a speed for reproducing data and recording data as is (i.e., without compressing such data), such as that which may occur in the above-described dubbing operation.

Accordingly, it is respectfully submitted that Suzuki as applied by the Examiner does not disclose dubbing speed as recited in claim 1. As a result, combining Ball, Suzuki, Yoshioka, Freeny, Jr., and Endoh in the manner proposed by the

Examiner would not result in the above-identified feature of claim 1.

Therefore, it is respectfully submitted that claim 1 is distinguishable from the combination of Ball, Suzuki, Yoshioka, Freeny, Jr., and Endoh applied by the Examiner. For reasons similar to those previously described with regard to claim 1, it is also respectfully submitted that independent claim 11 is distinguishable from the combination of Ball, Suzuki, Yoshioka, Freeny, Jr., and Endoh applied by the Examiner. Claims 2-10 and 12-18 are dependent from one of independent claims 1 and 11. Accordingly, it is also respectfully submitted that dependent claims 2-10 and 12-18 are distinguishable from the combination of Ball, Suzuki, Yoshioka, Freeny, Jr., and Endoh applied by the Examiner for at least the reasons previously described.

#### The Second Issue

Independent claim 1 recites in part the following:

"a record/playback unit . . . ;

a control unit configured to generate basic data for imposing payment . . . and configured to transmit the basic data for imposing payment, and . . . configured to cause the record/playback unit to start the recording . . . ; and

a payment imposing unit configured to determine, when receiving the basic data for imposing payment transmitted by the control unit an amount of payment . . . ,

wherein the control unit causes, when the dubbing speed is a standard dubbing speed, the record/playback unit to start the recording of the data out from the first recording medium onto the second recording medium at the standard dubbing speed without transmitting the basic data to said payment imposing unit." (Emphasis added.)

In the Examiner's Answer, the Examiner appears to acknowledge that Ball does not disclose *wherein the control unit causes, when the dubbing speed is a standard dubbing speed, the record/playback unit to start the recording of the data out from the first recording medium onto the second recording medium at the standard dubbing speed without transmitting the basic data to said payment imposing unit*, recited in claim 1. (See page 3, lines 20-23 of the Examiner's Answer.) In an attempt to overcome such deficiency, the Examiner relies on Yoshioka. It is respectfully submitted that Yoshioka as applied by the Examiner does not disclose such feature of claim 1.

More specifically, the above feature of claim 1 specifically recites a "control unit [which] causes . . . the record/playback unit to start the recording of the data . . . at the standard dubbing speed without transmitting the basic data to said payment imposing unit." Such feature involves "basic data" and a "payment imposing unit." Yoshioka as applied by the Examiner does not appear to disclose either of these elements.

With regard to the payment imposing unit, Yoshioka "does not disclose a payment imposing unit," as even acknowledged by the Examiner. (See line 1 of page 14 of the Examiner's Answer.) Accordingly, since Yoshioka does not have a payment imposing unit, Yoshioka can not disclose a control unit which "causes . . . recording of the data at the standard dubbing speed without transmitting the basic data to said payment imposing unit" as in claim 1.

With regard to the basic data, as recited in claim 1, the basic data may be generated "based on copyright holder ID read from a control data storage region (TOC) of the first recording medium, data indicative of a user identification, and data indicative of a dubbing speed selected by the user for recording the data read out from the first recording medium onto the second recording medium." It is respectfully submitted that Yoshioka as applied by the Examiner does not appear to specifically disclose such basic data. Accordingly, without

disclosing such basic data, Yoshioka can not disclose a control unit which "causes . . . recording of the data at the standard dubbing speed without transmitting the basic data to said payment imposing unit" as in claim 1.

Therefore, it is respectfully submitted that Yoshioka as applied by the Examiner does not disclose a control unit which "causes, when the dubbing speed is a standard dubbing speed, the record/playback unit to start the recording . . . without transmitting the basic data to said payment imposing unit," as in claim 1.

As a result, combining Ball, Suzuki, Yoshioka, Freeny, Jr., and Endoh in the manner proposed by the Examiner would not result in the above-identified feature of claim 1.

Therefore, it is respectfully submitted that claim 1 is distinguishable from the combination of Ball, Suzuki, Yoshioka, Freeny, Jr., and Endoh applied by the Examiner. For reasons similar to those previously described with regard to claim 1, it is also respectfully submitted that independent claim 11 is distinguishable from the combination of Ball, Suzuki, Yoshioka, Freeny, Jr., and Endoh applied by the Examiner. Claims 2-10 and 12-18 are dependent from one of independent claims 1 and 11. Accordingly, it is also respectfully submitted that dependent claims 2-10 and 12-18 are distinguishable from the combination of Ball, Suzuki, Yoshioka, Freeny, Jr., and Endoh applied by the Examiner for at least the reasons previously described.

### The Third Issue

Independent claim 1 recites in part the following:

"a payment imposing unit configured to determine, when receiving the basic data for imposing payment transmitted by the control unit an amount of payment based on the dubbing speed selected by the user and the copyright holder ID, and configured to transmit to the control unit the data indicative of proper completion of imposing payment when an electronic transfer of funds equal

to the determined amount of payment is withdrawn from an account of the user and transferred to an account specified by the copyright holder ID." (Emphasis added.)

In the Examiner's Answer, the Examiner appears to acknowledge that Ball does not disclose *and transferred to an account specified by the copyright holder ID*, as in claim 1. (See page 5, lines 3-4 of the Examiner's Answer.) In an attempt to overcome such deficiency, the Examiner relies on Freeny, Jr. and, in particular, lines 25-40 of column 13 thereof. It is respectfully submitted that this portion of Freeny, Jr. does not disclose such feature of claim 1.

More specifically, the portion of Freeny, jr. relied upon by the Examiner appears to indicate that a credit card of a consumer may be charged for a sale of a recording, or a credit card of the owner of the point of sale location may be charged for such sale. Although with regard to the latter situation such portion of Freeny, Jr. indicates that the "owner of the information" receives compensation, such portion of Freeny, Jr. does not appear to specifically disclose that such compensation is transferred to an account specified by the owner of the information. As is to be appreciated, such compensation may be merely mailed to the owner of the information in the form of a check.

Therefore, it is respectfully submitted that Freeny, Jr. as applied by the Examiner does not disclose the above identified feature of claim 1.

As a result, combining Ball, Suzuki, Yoshioka, Freeny, Jr., and Endoh in the manner proposed by the Examiner would not result in the above-identified feature of claim 1.

Therefore, it is respectfully submitted that claim 1 is distinguishable from the combination of Ball, Suzuki, Yoshioka, Freeny, Jr., and Endoh applied by the Examiner. For reasons similar to those previously described with regard to claim 1, it is also respectfully submitted that independent claim 11 is distinguishable from the combination of Ball,

Suzuki, Yoshioka, Freeny, Jr., and Endoh applied by the Examiner. Claims 2-10 and 12-18 are dependent from one of independent claims 1 and 11. Accordingly, it is also respectfully submitted that dependent claims 2-10 and 12-18 are distinguishable from the combination of Ball, Suzuki, Yoshioka, Freeny, Jr., and Endoh applied by the Examiner for at least the reasons previously described.

#### The Fourth Issue

Independent claim 1 recites in part the following:  
"a control unit configured to generate basic data for imposing payment based on copyright holder ID read from a control data storage region (TOC) of the first recording medium . . . ." (Emphasis added.)

In the Examiner's Answer, the Examiner appears to acknowledge that Ball does not disclose *read from a control data storage region (TOC) of the first recording medium*, as in claim 1. (See page 15, lines 5-6 of the Examiner's Answer.) In an attempt to overcome such deficiency, the Examiner relies on Endoh and, in particular, lines 55-60 of column 4, lines 35-45 of column 5, lines 45-55 of column 7, and Figure 7 thereof.

It is respectfully submitted that it would not have been obvious to combine Ball and Endoh in the manner proposed by the Examiner. With regard thereto, reference is made to *In re Fritch*, 23 USPQ 2d 1780 (CAFC 1992), in which the Court states at page 1783:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so'. Although couched

in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification....It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention". (Emphasis ours.)

The Examiner does not appear to have identified any portions in Ball or Endoh which teach or suggest the combination proposed by the Examiner.

Further, in describing the rejection of the above identified feature of claim 1, the Examiner relies on lines 5-20 of page 3 of Ball (in addition to the above-mentioned portion of Endoh). (See lines 4-5 of page 15 of the Examiner's Answer.) Such portion of Ball indicates that information relevant to the payment of royalties or copyright information would be "encoded onto video frames of coded audio information" or "on video frames along with a section of the audio information itself." (See lines 12-15 of page 3 of Ball.) The portion of Endoh relied on by the Examiner, on the other hand, appears to pertain to a point tape 19 for use with a digital audio tape recorder 11. Accordingly, it is respectfully submitted that one skilled in the art would not have considered it obvious to look to the audio tape recorder system of Endoh to modify the encoding copyright information arrangement of Ball.

Therefore, it is respectfully requested that the above rejection of claim 1 be withdrawn. For reasons similar to those previously described with regard to claim 1, it is also

respectfully requested that the above rejection of independent claim 11 be withdrawn.

Claims 2-10 and 12-18 are dependent from one of independent claims 1 and 11. Accordingly, it is also respectfully requested that the above rejection of claims 2-10 and 12-18 be withdrawn.

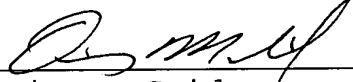
**CONCLUSION**

For all of the reasons set forth in Appellants' Appeal Brief and in this Reply Brief, the rejections of claims 1-18 should be reversed.

If there are any charges in connection with this Reply Brief, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: March 17, 2006

Respectfully submitted,

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